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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/016,110
Filing Date: December 17, 2001
Appellant(s): JOHNSTON, ALAN BERNARD

Melvin H. Pollack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 December 2005 appealing from the Office action mailed 27 July 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,820,260	Flockhart et al.	11-2004
6,456,601	Kozdon et al.	09-2002
5,991,374	Hazenfield	5,991,374

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18, 19, 21, 22, 24, 25, 27, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon et al. (6,456,601) in view of Flockhart et al. (6,820,260).

3. For claims 1, 7, 13, 19, 25, Kozdon teaches a data communication system (abstract) for providing content transmission col. 1, line 1 – col. 3, line 45) upon placement of a call on hold (col. 3, lines 64-67), the system comprising:

a. A server (Fig. 2, #40) configured to receive a message (col. 5, lines 33-44) from a first client (Fig. 2, #24) indicating the hold condition of the call with a second client (Fig. 2, #34); and

b. Another server (Fig. 2, #10) configured to store the content (col. 5, lines 45-53),

c. Wherein the first server is configured to transmit a request message, in response to the hold condition, for performing call control on behalf of the first client by

transmitting the request message to the other server to instruct the other server to transmit the content.

4. Kozdon does not expressly disclose that the first server generates a request message or simply forwards a request message from another unit or that the second server transmits the content directly to the second client. Flockhart teaches a method (abstract) of providing content and applets to callers on hold (col. 1, line 1 – col. 2, line 65), where a first party (Fig. 1, #109) is called by a second party (Fig. 1, #99 and #100), and contacts an on-hold handling server (Fig. 1, #107) which then contacts a content server (Fig. 1, #103) separate from 107 (col. 3, lines 50-53), in which 107 sends information to 103 (col. 4, lines 25-27) and 103 determines the content to provide to the caller (col. 4, lines 27-50). At the time the invention was made, one of ordinary skill in the art would have added Flockhart's server separation method to Kozdon in order to ensure that the on-hold server's resources are not tied up (col. 1, lines 20-30).

5. For claims 3, 9, 15, 21, 27, Kozdon teaches that the content includes at least one of music and messaging (col. 5, lines 50-51).

6. For claims 4, 10, 16, 22, 28, Kozdon teaches that the first client selects the content for transmission to the second client (col. 6, lines 3-5).

7. For claims 6, 12, 18, 24, 30, Kozdon teaches that the server sends a signaling message to the first client to instruct the first client to cease sending media to the second client (col. 4, lines 60-65).

8. Claims 2, 8, 14, 20, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon and Flockhart as applied to claims 1, 7, 13, 19, 25 above, and further in view of Anjum et al. (US 2001/0028654).

9. For claims 2, 8, 14, 20, and 26, Kozdon teaches that the server is configured to perform a proxying function (col. 5, line 33) according to an application layer protocol (col. 5, lines 18-27), but does not expressly disclose that the protocol includes a Session Initiation Protocol. Flockhart does not expressly disclose this limitation either. Anjum teaches a method (abstract) of providing telephony services (P. 1, Para 1 – P. 2, Para 15) in which functional application layers utilize SIP layers (P. 3, Para. 28-30). At the time the invention was made, one of ordinary skill in the art would have added SIP to Kozdon and Flockhart in order to enable dynamic service downloading (P. 4, Para. 39).

10. Claims 5, 11, 17, 23, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon and Flockhart as applied to claims 1, 4, 7, 10, 13, 16, 19, 22, 25, 28 above, and further in view of Hazenfield (5,991,374).

11. For claims 5, 11, 17, 23, and 29, Kozdon and Flockhart do not expressly disclose that the selected content is specified in a header of Session Initiation Protocol message from the first client to the server. Hazenfield teaches a method (abstract) of selecting and generating content for music-on-hold systems (col. 1, line 1 – col. 2, line 65) using such identification codes (col. 5, 18-40). At the time the invention was made, one of ordinary skill in the art would have added the selected content header to Kozdon and Flockhart in order to more efficiently remotely program the message playback (col. 1, line 65 – col. 2, line 15).

(10) Response to Argument

Applicant alleges that examiner does not expressly show that "a first server... transmitting a request message to the second server to instruct the other server to transmit the content to the second client. (Pp. 17-18)." The examiner notes that the claims as currently drawn do not expressly state a physical separation between the first and second servers, nor do they expressly state a direct transmission between the second server and second client, nor do they preclude said transmission from traveling through the first server.

Flockhart teaches an embodiment wherein "function 103 may be implemented by a separate adjunct processor which cooperates with ACD 107," where the adjunct processor includes content applets 97 and 98 (col. 3, lines 49-60), and wherein "function 103 customizes one of the applets 97-98 for any particular on-hold client 100 (col. 3, lines 59-61)." After customization, function 103 sends the customized applet to the second client, in response to the first server's request including negotiated wait time (col. 4, lines 5-50). That it does so through the first server is not precluded from the limitations as currently drawn.

The examiner had pointed out that, in addition to Flockhart, there is an argument regarding obviousness of physical separation of parts without change in functionality (P. 19). For purposes of rejection, the examiner relies solely on the Flockhart reference. However, in response to the applicant's arguments, it is well known in the art that a physical computer may house several software servers, wherein each server may in turn be comprised of software objects. The applicant has failed to claim physical separation between the first and second server. Further, the separation has occurred solely to physically separate functionality that is

already logically separated, without any disclosed teaching on a change in functionality due to separation, nor to any disclosed teaching on the benefits of such separation over a single server comprising full functionality.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to the applicant's allegation that Flockhart does not expressly disclose wherein the first client selects the content for transmission (P. 20 re claim 4), this is taught by Kozdon, the primary reference upon which Flockhart's structural aspects are added.

In response to applicant's argument that Flockart's method of content selection teaches away from Kozdon's method of content selection (Pp. 20-21), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Flockhart teaches the separation of a content server similar to Kozdon's content server, and thus suggests to one of ordinary skill in the art the applicability of logical and physical separation within the Kozdon system.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (P. 22), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references (Pp. 14-15), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kozdon teaches a need for greater efficiency in providing on-hold content (col. 2, lines 5-30). Flockhart is geared towards the same problem, and teaches further methods of improving efficiency for on-hold content, such as "tying up various resources (col. 1, lines 28-29)." This shared primary goal of efficiency would lead one of ordinary skill in the art who desires greater efficiency to seek out and combine such references, particularly since Flockhart promises efficiency gains over and above Kozdon's method.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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